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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,925	10/18/2004	Eng Shi Ong	984-PCT-US	7210

7590 04/30/2007
Law Offices of Albert Wai Kit Chan
World Plaza Suite 604
141 07 20th Avenue
Whitestone, NY 11357

EXAMINER

MOSS, KERI A

ART UNIT	PAPER NUMBER
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1743

MAIL DATE	DELIVERY MODE
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04/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/511,925	Applicant(s) ONG, ENG SHI	
	Examiner Keri A. Moss	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' Amendment filed February 13, 2007 is hereby acknowledged. Claims 1-3 and 4-20 are pending.

Response to Amendment

The new matter objection has been reconsidered and withdrawn.

The claim objections have been reconsidered and withdrawn.

The rejection under 35 USC 102(e) has been changed to a rejection under 35 USC 102(e) and 103(a) in light of applicant's arguments.

The rejections under 35 USC 103 have been maintained.

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims **1-3, 5-9, 11, 13 and 15-17** are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wai.
3. Wai positively teaches that a pressure of "about 25 atm" [approximately 25 bar] is "useful" in extraction (column 10 line 64-column 11 line 5) and this number overlaps applicant's claims. The applicant claims extraction at from about 10 to 25 bars while prior art Wai discloses extraction "between about 25 and 1000 atm." In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie

case of obviousness exists. In *re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In *re Geisler*, 116 F.3d 1465, 1469-71, 43 USPQ2d 1362, 1365-66 (Fed. Cir. 1997). In *In re Wertheim*, the prior art taught carbon monoxide concentrations of "about 1-5%" while the claim was limited to "more than 5%." The court held that "about 1-5%" allowed for concentrations slightly above 5% thus the ranges overlapped. In the present application, there is an overlap of ranges with the prior art. The overlap in the instant application is even more clear than the overlap in *Wertheim* because both the application and the prior art claim a range including a pressure "about 25" bar or atm.

In *In re Geisler*, a claim reciting thickness of a protective layer as falling within a range of "50 to 100 Angstroms" was considered prima facie obvious in view of prior art reference teaching that "for suitable protection, the thickness of the protective layer should be not less than about 10 nm [i.e., 100 Angstroms]." The court stated that "by stating that suitable protection' is provided if the protective layer is about' 100 Angstroms thick, [the prior art reference] directly teaches the use of a thickness within [applicant's] claimed range." With respect to the present application, prior art Wai positively teaches that "about 25 bar" is "useful" in extraction (column 10 line 64-column 11 line 5). This statement directly teaches the utility of using 25 bar of pressure within applicant's claimed range of 10-25 bars. Thus, Examiner has met the prima facie obviousness burden.

Claim Rejections - 35 USC § 103

4. Claims **1, 2 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable in view of Hartung (USP 4,176,228). This rejection is maintained from the previous office action. Applicant argues that Hartung does not suggest its method would work on plant materials or for extracting other extracts apart from glycyrrhizin, which is available in relatively larger fraction of the sample. This argument is incorrect and not commensurate in scope with applicants claims. It is incorrect because licorice root, the sample in Hartung is a plant material, as in claim 1. Also, glycyrrhizin is claimed in claim 14, therefore, Hartung anticipates that claim. Applicant's arguments are not commensurate in scope because the applicant has not claimed the limitation that the analyte must be available in a larger fraction of the sample.

Applicant's remaining arguments regarding Hartung relate to an interpretation of Hartung's intended teaching and what one of ordinary skill in the art might interpret from it. The Examiner disagrees with the arguments and finds them unpersuasive. In addition, these arguments of counsel cannot take the place of evidence in the record. MPEP 716.01(c).

5. Claims **1-9, 11, and 13-17** are rejected under 35 U.S.C. 103(a) as being unpatentable under Hartung (USP 4,176,228) in view of Wai (USP 6,524,628). This rejection is maintained from the previous office action. Examiner has met the burden of a prima facie case of obviousness by citing motivations to combine in at least one of the cited prior art references. Applicant's arguments attacking the references individually

when the rejection has been made based on combination of the references does not prove nonobviousness. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

6. Claims **10 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wai. This rejection has been discussed in the previous actions and is maintained as such.

7. Claims **18-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wai in view of Laugharn (WO 9922868 A1). Applicant's arguments that Laugharn's use of detergent is for lysing cells, which is a prelude to actual extraction does not differentiate Laugharn from the claimed invention. In claims 18-20, applicant claims a method for water-mediated extraction wherein the water contains one or more surfactant or detergent. In the example combining lysis with extraction, Laugharn uses water-based solvent containing detergent to lyse the cells then extract them. The water containing detergent is not removed before the pressurized extraction. Therefore, Laugharn teaches water mediated extraction wherein the water contains a detergent in accordance with claims 18-20.

Response to Arguments

8. Applicant's arguments regarding the 35 USC 102(e) rejection under Wai, filed February 13, 2007, with respect to the rejection(s) of claim(s) under **1-3, 5-9, 11, 13 and**

Art Unit: 1743

15-17 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Wai under 35 USC 102(e) or, in the alternative 35 USC 103.


9. Applicant's remaining arguments have been addressed above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keri A. Moss whose telephone number is 571-272-8267. The examiner can normally be reached on 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)272-1700. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jill Warden
Supervisory Patent Examiner
Technology Center 1700

Application/Control Number: 10/511,925
Art Unit: 1743

Page 7

Keri A. Moss
Examiner
Art Unit 1743

KAM 4/19/07